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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,845	10/29/2003	Stephen P. Mangin	792-114	9143
23869 7590 07/02/2009 HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791				
EXAMINER				
PRONE, CHRISTOPHER D				
ART UNIT		PAPER NUMBER		
3738				
MAIL DATE		DELIVERY MODE		
07/02/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/696,845

**Applicant(s)**

MANGIN ET AL.

**Examiner**

CHRISTOPHER D. PRONE

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 and 23-39 is/are pending in the application.
- 4a) Of the above claim(s) 5-7, 15-17, 24, 25, 28, 29, 31, 32 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-14, 23, 26, 27, 30, 33 and 35-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/30/09 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 8, 12-14, 23, 26, 27, 30, 33, 35, and 39 are rejected under 35 U.S.C. 103 as being unpatentable over Strecker United States Patent 5,653,748 in view of DiCaprio United States Patent Publication 2003/0121148 A1.

Strecker discloses the invention substantially as claimed being a prosthetic delivery device (10) comprising a flexible elongated member (11) having proximal and distal ends, a means for releasably securing an expandable stent prosthesis (15). The device further comprises a crocheted material (14) including a thread having a plurality of loops and a trigger pull release (24).

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However Strecker fails to disclose a visual marker comprising a colored loop extending around the prosthesis that is a different color than the releasing means.

DiCaprio discloses a stent having radiopaque bands that have different colors when looking fluoroscopically in the same field of endeavor for the purpose of enhanced trackability.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the radiopaque bands of DiCaprio with the delivery device of Strecker in order to enhance the trackability of the implant.

Claims 9-11 are rejected under 35 U.S.C. 103 as being unpatentable over Strecker as modified by DiCaprio as applied to claims 1-4, 8, 12-14, 23, 26, 27, 30, 33, and 35 above, and further in view of Ravenscroft United States Patent 5,480,423.

Strecker as modified by DiCaprio discloses the invention substantially as claimed being described supra. However, Strecker as modified by DiCaprio does not disclose that his prosthesis expands to a larger radius and a shorter length upon implantation

Ravenscroft teaches the use of a prosthetic delivery device comprising a length shortening self-expanding stent in the same field of endeavor for the purpose of providing a concentrated expansion force within a body lumen, shown best in figures 2a – 2f.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the stent of Ravenscroft with the delivery device of Strecker as modified by DiCaprio in order to provide a concentrated expansion force within a body lumen, which can be accurately tracked by the operator throughout the insertion process.

Claims 36-38 are rejected under 35 U.S.C. 103 as being unpatentable over Strecker as modified by DiCaprio as applied to claims 1-4, 8, 12-14, 23, 26, 27, 30, 33, and 35 above, and further in view of Fischell et al United States Patent 5,792,144

The combination of Strecker as modified by DiCaprio discloses the invention substantially as claimed being described supra. However, the combination does not disclose that the radiopaque bands comprise silicone.

Fischell teaches the use of a stent delivery catheter comprising bands of a radiopaque metal coated in silicone in the same field of endeavor for the purpose of providing a durable visible marker for the operator.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the silicone coating with marker bands of Strecker as modified by DiCaprio in order to provide a durable visible marker for the operator.

### ***Response to Arguments***

Applicant's arguments filed 4/30/09 have been fully considered but they are not persuasive. The applicant argues that the markers of DiCaprio fail to meet the new claim limitations. The examiner disagrees because the markers are a different material and texture than the surrounding portions. DiCaprio discloses a plurality of metals capable of being used for radiopaque materials such as gold and platinum. If the markers are made from Gold or Platinum they would reflect yellowish gold colored light waves or silverfish platinum light waves both of which would reflect light of a different wavelength that is visible to the naked eye of the operator. The examiner does not believe there are any commonly used radiopaque materials in the surgical art that are invisible to the naked eye. Therefore because of the natural range of colors of the materials disclosed by DiCaprio it would be obvious that the device would comprise first and second colors.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory

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action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER D. PRONE whose telephone number is (571)272-6085. The examiner can normally be reached on Monday through Fri 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher D Prone  
Examiner  
Art Unit 3738

/Christopher D Prone/

/Corrine M McDermott/

Supervisory Patent Examiner, Art Unit 3738